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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/499,069 02/04/00 WRIGHT

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| EXAMINER |
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| CARTER, M | |
| ART UNIT | PAPER NUMBER |

3722
DATE MAILED:

10
04/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/499,069

Applicant(s)

WRIGHT, TED EUGENE

Examiner

Monica S. Carter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed February 15, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 15 February 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on February 15, 2001.

These drawings are approved.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton (4,850,611) in view of Cowan ('396) and further in view of Thompson ('119). Skelton discloses a single sheet form (23) (advertising medium for use in promoting hotels, restaurants, and the like (col. 1, lines 6-14)) comprising an unfolded form including a number of lines of perforations (44, 46, 48, 50, 52, 54, 56, and 58); the form including pre-printed textual and graphical information (col. 4, lines 53-65); the form being rectangular and having a greater vertical dimension than a horizontal dimension (col. 4, lines 28-35); and a lower tab (43) being separated from a central portion of the form by a horizontal line of perforations (45); wherein a packet is formed by folding the packet about the horizontal line of perforations and then about the vertical line of perforations.

Skelton discloses the claimed invention except for a registration form placed at the top portion of the form and separated from the form by a line of perforations.

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Cowan discloses a form (12) having a tab portion (form) (22) extending from the top of the form (12) and separated from the form (12) by a line of perforations (54). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a detachable form at the top of the packet, as taught by Cowan, to provide an additional detachable flap for surrendering to someone for registration, ticketing, couponing, etc.

Regarding the form being a registration form, in particular, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the form (tab portion) of Cowan is capable of performing the intended use of being a registration form, as claimed.

Skelton, as modified by Cowan, discloses the claimed invention except for one or more die-cut slots in the unfolded packet for retaining a number of keys.

Thompson discloses an envelope having a slot (42) which is capable of retaining a key, key card, ticket, or the like. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a slot, as taught by Thompson, to provide a retention means for items to be placed in the packet.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton in view of Cowan and Thompson and further in view of Holcomb et al. ('085).

Skelton, as modified by Cowan and Thompson, discloses the claimed invention except for the key being selected from a group consisting of metal and magnetic key cards.

Holcomb et al. discloses an environmental control lock system comprising the use of a magnetic key card (12). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a magnetic key card for opening a locked door, as taught by Holcomb et al., to provide a secure means of ensuring authorized entry into a room and/or area.

Response to Arguments

5. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's argument that Holcomb does not disclose a key packet or envelope for containing a key card, Holcomb is solely used for the teaching of a magnetic key card and has not been relied upon for the teaching of a key packet or envelope.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shannon (4,723,794) discloses a guest check and Laughlin (5,529,172) discloses a combination guest identification card and entry means holder.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



mc
April 25, 2001



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700